

WIPO



PCT/R/WG/7/5
ORIGINAL: English
DATE: April 5, 2005

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, May 25 to 31, 2005

RECORDING OF CHANGES BY THE INTERNATIONAL BUREAU

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations¹ relating to the recording of changes concerning the person, name and address, etc., of applicants, inventors and agents in respect of international applications under the PCT. Applicants would benefit greatly from having the possibility for the single recording of a change under Rule 92bis to have effect for the purposes of the national procedure before a number of designated and elected Offices. The proposals thus afford applicants the option of requesting the recording of changes not only, as at present, during the international phase before the expiration of 30 months from the priority date but also after the expiration of 30 months from the priority date in respect of designated and elected Offices before which the national phase processing of the international application has started and has not yet been completed. The proposals would not apply to granted patents.

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

2. Changes in the name, address, nationality and residence of the applicant or inventor recorded by the International Bureau would have effect under the applicable national law of those Offices (subject to certain exceptions and a reservation provision). However, changes in the person of the applicant or the inventor, or in the person, name and address of the agent and the common representative, or in the address for correspondence, would have effect only if so provided under the applicable national law of designated and elected Offices.

3. The proposals are also intended to achieve consistency, to the extent possible, with provisions of the PLT relating to the recording of changes.

4. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and comments received on preliminary draft documents made available since then.

BACKGROUND

5. At its fifth session, the Working Group agreed that the International Bureau should study the possibility of providing for a request, to be made in a single document submitted to the International Bureau, to record certain changes concerning the applicant, inventor, licensees or security interests in respect of two or more designated or elected Offices in which the international application had entered the national phase, similar to the procedure under Article 14(1)(b) and Rules 15, 16 and 17 of the Patent Law Treaty (PLT) (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 105).

6. During its sixth session, the Working Group discussed proposals by the International Bureau for setting up a system, under the PCT, which would facilitate, for both applicants and Offices, the recording of certain changes in respect of an international application which has entered the national phase before several designated or elected Offices, or of a patent granted on the basis of such an international application. The Working Group's discussions are outlined in document PCT/R/WG/6/12, paragraphs 108 to 121, reproduced in the following paragraphs:

“SINGLE REQUEST FOR THE RECORDING OF CHANGES DURING THE NATIONAL PHASE

“108. Discussions were based on document PCT/R/WG/6/10.

“109. There was considerable support in the Working Group for further consideration of the concept of permitting requests to be made centrally for the recording of certain changes in respect of international applications which have entered the national phase, noting the significant consequential benefits that would accrue if greater communication resulted in common formats and easier access to patent data for information and statistical purposes.

“110. The Working Group invited the Secretariat to prepare revised proposals for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

“111. Some delegations expressed concern as to the legal basis in the Treaty for making Rules for procedures extending well into the national phase of processing of international applications. Some delegations felt that the regulation-making power in Article 58(1)(ii) was not a sufficient basis to establish procedures for which there was no general basis in the substantive Articles of the Treaty. Other delegations, however, felt that there was an adequate basis, noting, in particular, that the proposals were consistent with the aims of the Treaty as expressed in the preamble and were in no way inconsistent with any specific provision of the Treaty.

“112. Some delegations noted that the Treaty in general governed procedures only to the end of the international phase, whereas, after national phase entry, the application became subject solely to national law. Concerns were expressed that introducing such a system might have consequential effects on the way in which other provisions in the Regulations were interpreted.

“113. Other delegations pointed out that the international and national phases were not distinctly defined by the Treaty or Regulations, and that, in fact, certain features of the Treaty dealt specifically with matters obtaining long after the international phase was over. Those features included the fundamental principle that an international application has, for the purposes of the national law in all designated States, the effect of a regular national application having as its filing date the international filing date accorded under the Treaty (see Article 11). Other such features related to the provision of information (see Article 50), and the prohibition on requirements relating to the form or contents being applied to the application additional to those provided for in the Treaty and Regulations (see Article 27(1)).

“114. Some delegations were of the view that the proposed system should only be applied in respect of changes concerning pending applications but should not apply to changes concerning granted patents.

“115. It was generally agreed, as was proposed, that any such system should be limited, at least at the outset, to changes in the name and address of applicants, agents and inventors, noting that it would be difficult to achieve agreement at this stage on the kind of evidence which should be required for other kinds of matter.

“116. A number of delegations were concerned that the proposed system would not be compatible with national laws which require the applicant to notify changes directly to the designated Office in a particular manner and with prescribed kinds of evidence, particularly in the case of a change of name. Moreover, it was noted that dealing with fees might pose difficulties. Consequently, it was felt that participation in any system would need to be on a voluntary basis for designated Offices or subject to transitional reservation provisions, although it was pointed out that the usefulness of the system would be considerably less if a significant number of Offices were to opt out of it.

“117. One delegation expressed its concern that it would be too difficult to incorporate the proposed new system into established national procedures and that the new system would consequently result in greater, rather than less, work in designated Offices. It was noted, however, that certain checks would be carried out centrally by the International Bureau rather than the designated Offices concerned, meaning that there ought rarely to be any action required by designated Offices other than the recording

itself. Other delegations considered that such a system ought to be very beneficial and should be considered further, even if it would imply changes to established national laws and systems.

“118. One representative of users suggested that, since local agents needed to be informed about any changes concerning international applications which had entered the national phase, almost the same amount of work would be involved for the applicant as under the current system. The representative also expressed concern about the reliability of the new system in case of different applicants for different designated States or in case of multiple divisional applications divided from an international application which had entered the national phase, and suggested that a central register of ownership details would be desirable.

“119. Delegations were generally content with the proposal that the applicant’s request to the International Bureau could be made in either English or French, but some expressed the view that the communication from the International Bureau to the designated Office would need to be in a language accepted by the Office. It was noted that this difficulty would be largely overcome by use of forms using standard language which could be translated into several languages. Delegations of two Contracting States whose official languages used alphabets other than the Latin alphabet stressed the need for translations.

“120. One delegation expressed the view that, even if the applicant could make a request for recording of a change centrally to the International Bureau, each designated Office ought to notify the applicant when the change had actually been made.

“121. Some delegations stated that, in order for such a system to work reliably, appropriate information technology systems would be needed both at the International Bureau and at the designated Offices. One delegation suggested that the proposal might be premature in that the International Bureau had not yet completed its systems for processing PCT applications in electronic form in the international phase. A delegation from a developing country considered that technical assistance would be required in some cases to ensure that Offices had the necessary capacity to handle electronic files.”

7. The Annex to this document contains revised proposals, taking into account the discussions, and the agreement reached, at the sixth session, comments received on a preliminary draft document for the seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 5. The main features of the revised proposals are outlined in the following paragraphs.

RECORDING OF CERTAIN CHANGES BY THE INTERNATIONAL BUREAU DURING THE INTERNATIONAL PHASE AND THE NATIONAL PHASE OF PROCESSING

8. Noting the considerable support in the Working Group at its sixth session for further consideration of the concept of recording of changes by the International Bureau during the national phase, it is proposed to amend Rule 92bis so as to allow requests for recording of certain changes to be made not only during the international phase (before the expiration of 30 months from the priority date) but also during the national phase (after the expiration of 30 months from the priority date) in respect of designated or elected Offices before which national processing of the international application has started and has not yet been completed. The proposals would not, however, apply to granted patents.

9. Changes recorded under Rule 92bis would have, depending on their nature, either optional or automatic effect under the applicable national law of designated and elected Offices concerned (see paragraphs 21 to 27, below).

10. The possibility for the single recording of a change under Rule 92bis to have effect for the purposes of the national procedure before a number of designated and elected Offices would have clear advantages for applicants. It would allow applicants to deal with one office, with one set of requirements, to make only one fee payment, and to file one request (or a limited number of requests) for the recording of changes in respect of all affected international applications filed by the same applicant. It would reduce administrative work for applicants, minimize the difficulties of working in various languages and of meeting different legal requirements, and reduce overall fees.

11. It is intended that this possibility would be an alternative to the existing possibility (which would be maintained) of filing separate requests directly with each designated and elected Office.

12. Concern was expressed by some delegations during the sixth session of the Working Group as to the legal basis in the Treaty for making Rules for procedures extending into the national phase of processing of international applications. Moreover, concerns have been expressed as to the basis in Article 58 for providing Rules concerning procedures for which there was no general basis in the substantive Articles of the Treaty (see paragraphs 111 and 112 of the Chair's summary, reproduced in paragraph 6, above).

13. It is to be noted that, while PCT procedures are principally concerned with the international phase, the Treaty and Regulations are not limited in their operation to that phase. Certain features of the Treaty and the Regulations deal specifically with matters obtaining long after the international phase is over. Those features include, for example, the fundamental principle that an international application has, for the purposes of the national law in all designated and elected States, the effect of a regular national application having as its filing date the international filing date accorded under the Treaty (see Article 11). Other such features relate to the opportunity to amend the application during the national phase (see Articles 28 and 41), to the prohibition against national requirements relating to the form or contents different from or additional to those provided for in the Treaty and Regulations (see Article 27(1)), the provision of patent information services (see Article 50), and the furnishing by designated and elected Offices to the International Bureau, after the start of national processing, of copies of translations of the international application furnished by the applicant (see Rule 95).

14. Moreover, the proposals for recording of certain changes by the International Bureau after the expiration of 30 months from the priority date appear consistent with the objectives of the Treaty, as expressed in the preamble, in particular, the objective "to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries." To that extent, Article 58(1)(iii) would appear to provide a sufficient basis for providing Rules concerning procedures which would further those objectives.

REQUIREMENTS UNDER RULE 92BIS AS PROPOSED TO BE AMENDED

Filing of Requests

15. As at present, Rule 92bis as proposed to be amended would allow applicants to submit a request for the recording of a change either directly to the International Bureau or to the receiving Office. In the latter case, the request would be considered to have been received by the receiving Office on behalf of the International Bureau, and the receiving Office would promptly transmit it to the International Bureau.

Indications Which May Be Changed

16. As at present, Rule 92bis as proposed to be amended would provide for the recording of changes by the International Bureau in the following indications appearing in the request or the demand: the person, name, residence, nationality or address of the applicant; the person, name or address of the inventor; and the person, name or address of the agent or the common representative. In addition, Rule 92bis.1 as proposed to be amended would also provide for the recording of a change in the address for correspondence (as provided in PLT Rule 15(8)).

Transliteration or Translation of Indications

17. Noting the concerns expressed at the sixth session with regard to the need for translations or transliterations for designated or elected States whose official languages used alphabets other than the Latin alphabet, the revised proposals provide as follows:

- (a) where the indications to be changed are written in characters other than those of the Latin alphabet, the applicant would be required to furnish the same in characters of the Latin alphabet, either as a mere transliteration or through translation into English;
- (b) where, on the other hand, the indications to be changed are written in characters of the Latin alphabet and the applicant desires the change to be effective in a designated or elected State whose official language or languages use characters other than those of the Latin alphabet and which has notified the International Bureau of the need for a transliteration or translation, the applicant would be required to furnish the same indications also in those other characters, either as a mere transliteration or through translation into the language concerned;
- (c) where the applicant does not furnish a required transliteration or translation, the International Bureau would nevertheless record the changes but, as far as designated or elected Offices which had notified the International Bureau of the need for a transliteration or translation are concerned, such changes would have effect only if so provided for under the applicable national law of the designated or elected Offices concerned; in other words, it would be a matter for the national law applicable by the designated or elected Office to provide whether, and under which circumstances, any such change would have effect under the national law applied by that Office.

Persons Entitled to Make Requests

18. As at present, under Rule 92bis as proposed to be amended, a request for the recording of a change could be made: (i) in any case, by the applicant; (ii) in the case of a change in the person of the applicant, by the person seeking to be recorded as applicant ("the new applicant"); (iii) in the case of a change in the person of the agent or the common

representative pursuant to the renunciation of an appointment as agent or common representative, by the agent or the common representative concerned; and (iv) by the receiving Office acting pursuant to the applicable national law.

19. Where the request for the recording of a change in the person of the applicant was made by the new applicant, the International Bureau would continue to require, as at present, the furnishing of documentary evidence supporting the change before recording any such change. Furthermore, as at present, in such a case, where the previous applicant objects to the change in writing, any such change would be considered not to have been recorded. However, rather than leaving these important matters to the Administrative Instructions and the PCT Applicant's Guide, as is presently the case, it is proposed to clarify the practice in Rule 92bis itself.

Timing of Requests

20. Under Rule 92bis as proposed to be amended, requests for recording of a change could be made before or after the expiration of 30 months.

Effect of Recorded Changes for the Purposes of National Procedure Before Designated and Elected Offices

21. At the sixth session of the Working Group, it was generally agreed that a system for the recording of certain changes with effect for the national procedure before designated and elected Offices should be introduced, but that it should be limited, at least at the outset, to changes in respect of which, in general, in line with PLT Rule 15, no further documentary evidence supporting the change may be required, noting that it would be difficult to achieve agreement at this stage on the kind of evidence which should be required for other kinds of matter (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraph 115).

— *change in the name, address, nationality or residence of the applicant, or in the name or address of the inventor*

22. It is thus proposed that any change in the name, address, nationality or residence of the applicant, or in the name or address of the inventor (that is, any change concerning the applicant and the inventor, other than a change in the person of the applicant or in the person of the inventor) that is recorded by the International Bureau and notified to a designated or elected Office before the processing of the international application has started in that Office, or after such processing has started but before it has been completed, should in general have automatic effect under the applicable national law of the designated or elected Office concerned.

23. A change recorded by the International Bureau would not have effect in a designated or elected State if the designated or elected Office, a court or any other competent organ found that a requirement for the recording of the change by the International Bureau had not been complied with. However, no designated or elected Office would be permitted to review the decision by the International Bureau to record a change unless that Office may reasonably doubt the veracity of an indication contained in the request for recording of the change or of a supporting document or a translation thereof, in which case it would be required to invite the applicant to furnish evidence to it within a time limit which shall be reasonable under the circumstances.

24. A change recorded by the International Bureau would also not have effect in a designated or elected State in which the relevant provisions did not apply consequent to a notification that the provisions concerned were not compatible with its national law. It is to be understood that such reservation could be made in respect of changes recorded by the International Bureau based on requests by the applicant received before and/or after the expiration of 30 months from the priority date. It is suggested that this understanding be expressed by the Assembly in amending the Regulations. For example, where a designated or elected Office made use of the reservation provision in respect of changes recorded by the International Bureau based on request by the applicant received after the expiration of 30 months from the priority date, any such change recorded by the International Bureau concerning the name, address, nationality and residence of the applicant, or the name and address of the inventor would have no effect in respect of that Office, and the applicant would have to request the recording of the change, upon or after national phase entry, under the applicable national law of that Office. The Administrative Instructions would have to be modified so as to provide that, where the applicant nevertheless included any such Office in his request received by the International Bureau after the expiration of 30 months from the priority date, the International Bureau would be required to notify the applicant accordingly.

— *change in the person of the applicant or in the person of the inventor*

25. It is proposed that any change in the person of the applicant or in the person of the inventor (that is, changes in respect of which, in general, in compliance with PLT Rule 16, further documentary evidence supporting the change may be required) which is recorded by the International Bureau and notified to a designated or elected Office before the processing of the international application has started in that Office, or after such processing has started but before it has been completed, would have effect only if so provided by the applicable national law of the designated or elected Office concerned. In other words, as at present with regard to changes in the person of the applicant or the inventor recorded during the international phase, it would be a matter for the national law applicable by the designated or elected Office to provide whether, and under which circumstances, any such change would have effect under the national law applied by that Office.

26. Alternatively, the Working Group may wish to consider whether the Regulations under the PCT should be further aligned with the PLT by providing that a change in the person of the applicant or in the person of the inventor recorded by the International Bureau under Rule 92bis would, in general, have to be recorded by any designated or elected Office concerned, and would have effect under the applicable national law of that Office, provided that any such Office would be free to require, if it so wishes, (further) documentary evidence supporting the change, consistently with the corresponding provisions of PLT Rule 16(2), (3) and (4), which would have to be incorporated into Rule 92bis accordingly (further amended so as to also apply to changes in the person of the inventor; as noted above, the PLT does not apply to changes in the person of the inventor).

— *change in the person, name and address of an agent or common representative, or of a change in the address for correspondence*

27. As regards changes in the person, name and address of an agent or common representative, or of a change in the address for correspondence recorded by the International Bureau under Rule 92bis, it is to be noted that agents and common representatives appointed to represent the applicant during the international phase usually are not, and cannot be, appointed to represent the applicant during the national phase before more than one of the

designated and elected Offices. Similarly, an address for correspondence used for the purposes of international phase processing usually is not, and generally cannot be, used as an address for correspondence for the purposes of national phase processing before more than one of the designated and elected Offices. While it is proposed to notify the designated or elected Offices of any such change recorded by the International Bureau, noting that up-to-date information concerning agents, common representatives and address for correspondence may be of importance to designated or elected Offices in order to be able to contact the applicant in the context of national phase entry, it is not proposed to require the designated or elected Offices to record any such change. Any such change notified to a designated or elected Office would have effect only if so provided under the applicable national law of the Office concerned.

Further Requirements

28. The requirements under Rule 92bis as proposed to be amended have been aligned to the corresponding requirements under PLT Rules 15 and 16, respectively, in particular with regard to the contents of any request for the recording of a change, the requirements where a single request relates to more than one international application, the evidence which the International Bureau may require in support of a request of a change, and the invitation procedure where a request does not comply with the formal requirements. (Note, however, that the PLT does not apply to changes in the person, name or address of the inventor, or to changes in the person of the agent and common representative; see PLT Rules 15 and 16).

Fees

29. It is proposed that the submission *before* the expiration of 30 months from the priority date of a request for the recording of a change under Rule 92bis would, as at present, not be subject to the payment of a fee, whereas the submission *after* the expiration of 30 months from the priority date would be subject to the payment of a fee, for the benefit of the designated or elected Offices concerned by the change, and of the International Bureau.

30. Where the request for the recording of a change is made *before* the expiration of 30 months from the priority date, any designated or elected Office would usually be notified of the recordal of such change at the same time as other documents required for the processing of the international application are communicated by the International Bureau to that Office under the International Bureau's "communication on request" system. Processing of the international application would thus start before that Office on the basis of the changes recorded by the International Bureau, so that it would not appear to be justified to subject the submission of such a request to the payment of a fee for the benefit of the designated or elected Office concerned.

31. However, where the request for the recording of a change is made *after* the expiration of 30 months from the priority date, designated and elected Offices would usually be notified of the recordal of such change only after the processing of the international application has started before designated or elected Offices concerned, in which case it would appear justified to subject the submission of such a request to the payment of a fee for the benefit of the designated and elected Offices concerned by the change. Moreover, since a request made after the expiration of 30 months would be after the expiration of the period within which the International Bureau usually processes the international application, it would appear justified to subject the submission of such a request also to the payment of a fee for the benefit of the International Bureau. It is thus proposed to fix, in the Administrative Instructions, a fee

which would consist of two components: a basic component for the benefit of the International Bureau, and an additional component for the benefit of the designated or elected Offices concerned by the change (note that any request for the recordal of a change submitted after the expiration of 30 months from the priority date would have to indicate the designated or elected Offices in respect of which the change is desired to be effective). Proposed modifications of the Administrative Instructions to fix the fee would, of course, be subject to consultations with all interested Offices and Authorities in accordance with Rule 89.2(b).

32. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

RECORDING OF CHANGES BY THE INTERNATIONAL BUREAU

TABLE OF CONTENTS

Rule 76 Translation of Priority Document; Application of Certain Rules to Procedures Before Elected Offices.....	2
76.1, 76.2 and 76.3 [Remain deleted].....	2
76.4 [No change].....	2
76.5 Application of Certain Rules to Procedures Before Elected Offices.....	2
Rule 92bis Recording of Changes in Certain Indications <u>Concerning the Applicant, Inventor, Agent, Common Representative and Address for Correspondence in the Request or the Demand</u>	3
92bis.1 <u>Recording of Changes in Indications in the Request or Demand by the International Bureau</u>	3
92bis.2 <u>Request for Recording of a Change</u>	4
92bis.3 <u>Evidence; Translation; Fee</u>	9
92bis.4 <u>Processing of Request for Recording of a Change</u>	10
92bis.5 <u>Objection to Change</u>	12
92bis.6 <u>Changes with Automatic Effect Under National Law</u>	13
92bis.7 <u>Changes with Effect only if Provided by National Law</u>	14

² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures Before Elected Offices

76.1, 76.2 and 76.3 [Remain deleted]

76.4 [No change]

76.5 Application of Certain Rules to Procedures Before Elected Offices

Rules 13ter.3, 22.1(g), 47.1, 49, 49bis, and 51bis and 92bis shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure the application of Rule 92bis to the procedures before elected Offices.]

(i) [No change] any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) to (v) [No change]

Rule 92bis

Recording of Changes in Certain Indications Concerning the Applicant, Inventor, Agent, Common Representative and Address for Correspondence in the Request or the Demand

92bis.1 Recording of Changes in Indications in the Request or Demand by the International Bureau

(a) The International Bureau shall, on ~~a~~ the request ("request for recording of a change") made in accordance with Rules 92bis.2 and 92bis.3, of the applicant or the receiving Office, record ~~a change~~ changes in any of the following indications appearing in the request or demand:

(i) the person, name, residence, nationality or address of the applicant;

(ii) the person, name or address of the inventor;

(iii) the person, name or address of the agent, or the common representative or the inventor;

(iv) the address for correspondence.

(b) [Deleted] The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.

92bis.2 Request for Recording of a Change

(a) A request for recording of a change may be made:

(i) in any case, by the applicant;

(ii) in the case of a change in the person of the applicant, by the person seeking to be recorded as applicant ("new applicant");

(iii) in the case of a change in the person of the agent or common representative pursuant to the renunciation of an appointment as agent or common representative, by the agent or common representative concerned;

(iv) by the receiving Office acting pursuant to the applicable national law.

[COMMENT: As under present Rule 92bis.1, it is proposed to continue to provide that a request for recording of a change may be made by the receiving Office so that effect can be given to decisions under the national law, for example, in disputes between parties as to ownership.]

(b) A request for recording of a change may be submitted to the International Bureau or to the receiving Office and may be submitted at any time, whether before or after the expiration of 30 months from the priority date. Where a request is submitted to the receiving Office, it shall be considered to have been received by that Office on behalf of the International Bureau.

[Rule 92bis.2(b), continued]

[COMMENT: The Administrative Instructions would have to be modified to provide that, where the request is received by the receiving Office on behalf of the International Bureau, that Office should mark the date of receipt on the request and promptly transmit it to the International Bureau.]

(c) A request for recording of a change shall indicate:

(i) the number of the international application concerned;

[COMMENT: See PLT Rules 15(1)(ii) and 16(1)(ii).]

(ii) the relevant indication referred to in Rule 92bis.1 and details of the change;

and

[COMMENT: See PLT Rules 15(1)(iii) and (iv).]

(iii) where the request is submitted after the expiration of 30 months from the priority date, the designated State or States in respect of which the change is desired to be effective;

and, where the request for recording of a change concerns the person of the applicant or the inventor, shall further indicate:

[Rule 92bis.2(c), continued]

(iv) the name and address of the person recorded as applicant or inventor, as applicable, prior to the change;

[COMMENT: See PLT Rule 16(1)(iii).]

(v) the name, residence, nationality and address of the new applicant or the name and address of the person to be recorded as inventor, as applicable;

[COMMENT: See PLT Rule 16(1)(iv) and (vi).]

(vi) the date of the change;

[COMMENT: See PLT Rule 16(1)(v).]

(vii) the basis for the change.

[COMMENT: See PLT Rule 16(1)(vii).]

[Rule 92bis.2, continued]

(d) Where any indication referred to in Rule 92bis.1 is written in characters other than those of the Latin alphabet, the same shall also be indicated in characters of the Latin alphabet, either as a mere transliteration or through translation into English. Where any indication referred to in Rule 92bis.1 is written in characters of the Latin alphabet and the change is desired to be effective in respect of a designated Office which has informed the International Bureau under paragraph (e) that it requires that such indications be written in other characters, the same shall also be indicated in those other characters, either as a mere transliteration or through translation into the language concerned. The applicant shall decide which words will be merely transliterated and which words will be translated.

[COMMENT: See paragraph 17 in the main body of this document.]

(e) A designated Office which requires any indication referred to in Rule 92bis.1 to be written in characters other than those of the Latin alphabet, either as a mere transliteration or through translation into the official language, or one of the official languages, of the designated State concerned, shall inform the International Bureau accordingly. Any information received by the International Bureau shall be promptly publish by the International Bureau in the Gazette.

[COMMENT: See paragraph 17 in the main body of this document.]

[Rule 92bis.2, continued]

(f) Where an indication is required under paragraph (c)(iii) as to the designated State or States in respect of which a change is desired to be effective but no such indication is contained in the request for recording of the change, that request shall be considered to indicate that it is in respect of all designations and elections in force in respect of the international application at the time when that request is submitted.

(g) The submission in accordance with Rule 90 of a document appointing an agent or a common representative, or revoking or renouncing such an appointment, shall be considered to be a request for recording of a change in the person of the agent or the common representative concerned.

[COMMENT: See present Section 425 of the Administrative Instructions. In the context of the proposed amendment of Rule 92bis, it is proposed to move the contents of present Section 425 of the Administrative Instructions to the Regulations so as to deal with all issues relating to the recording of changes in just one place. The Administrative Instructions would have to be modified accordingly.]

(h) A single request for recording of a change may be submitted in respect of:

(i) changes in more than one kind of indication;

(ii) a change relating to more than one international application, provided that, in respect of all of the applications concerned, the application numbers are separately indicated, the same person is applicant, and the same change is requested.

[Rule 92bis.2(h), continued]

[COMMENT: See PLT Rules 15(3) and 16(5). Where a single request for recording of a change is filed relating to two or more international applications, the International Bureau would, of course, issue separate notifications under Rule 92bis.4(c) in respect of each international application concerned.]

92bis.3 Evidence; Translation; Fee

(a) Where a request for recording of a change in the person of the applicant is made by the new applicant, it shall be accompanied by documentary evidence of the change.

[COMMENT: See PLT Rule 16(2).]

(b) The International Bureau may require the furnishing of documentary evidence, or of further documentary evidence where evidence has been furnished under paragraph (a), in support of a request for recording of a change where that Bureau may reasonably doubt the veracity of an indication contained in the request or of the evidence furnished under paragraph (a), or the accuracy of a translation thereof.

[COMMENT: See PLT Rules 15(4) and 16(6).]

(c) The International Bureau may require the furnishing of a translation of any documentary evidence furnished under paragraph (a) or (b) that is not in the same language as the international application to which it relates or, where a translation of the international application has been furnished under Rule 12.3 or 12.4, in the language of that translation.

[Rule 92bis.3, continued]

(d) The submission after the expiration of 30 months from the priority date of a request for recording of a change may be subjected by the International Bureau to the payment of a special fee whose amount shall be fixed in the Administrative Instructions.

[COMMENT: See paragraphs 29 to 31 in the Introduction to this document.]

92bis.4 Processing of Request for Recording of a Change

(a) Where a requirement under Rule 92bis.2 or 92bis.3 is not complied with, the International Bureau shall invite the person making the request for recording of a change to comply with that requirement, and to make observations, within two months from the date of the invitation, failing which the International Bureau shall refuse the request and shall notify that person accordingly, provided that a request shall not be refused merely because of non-compliance with Rule 92bis.2(d)(ii).

[COMMENT: See PLT Rules 15(6) and 15(7), and PLT Rule 16(8). With regard to the proviso at the end of paragraph (a), see paragraph 17 in the main body of this document.]

(b) Where the International Bureau, after considering evidence furnished under Rule 92bis.3(b), still reasonably doubts the veracity of an indication contained in the request for recording of a change, it shall refuse the request and shall notify the person making the request accordingly.

[Rule 92bis.4, continued]

(c) Where the International Bureau is satisfied that the requirements of Rules 92bis.2 and 92bis.3 are complied with, it shall promptly record the change concerned under Rule 92bis.1 and notify the receiving Office, the International Searching Authority, the International Preliminary Examining Authority, the designated Offices concerned, the applicant and, in the case referred to in Rule 92bis.2(a)(ii), the agent or common representative concerned, in accordance with the Administrative Instructions. Where the change concerns the person of the applicant, the International Bureau shall notify both the new applicant and the previously recorded applicant.

[COMMENT: The Administrative Instructions (see present Sections 422 and 425) would have to be modified to prescribe the details as to who (receiving Office, International Searching Authority, International Preliminary Examining Authority, designated/elected Offices, applicant and/or new applicant) should be notified of a change recorded by the International Bureau, depending on when (before or after the expiration of 30 months from the priority date) and in respect of which indication referred to in Rule 92bis.1 the request for recording of a change was made. Moreover, the Administrative Instructions would have to be modified to clarify that, where a single request for the recording of a change was filed in respect of multiple applications, the International Bureau would issue, if so desired by a designated or elected Office which was not yet bound by the Patent Law Treaty, separate notifications for each international application concerned by the change.]

(d) The International Bureau shall, upon the request of a designated Office receiving a notification under paragraph (c), transmit to it a copy of the request for recording of a change and of any documentary evidence or translation furnished under Rule 92bis.3.

[COMMENT: It is proposed to add paragraph (d) so as to make available to designated or elected Offices the necessary documentation for a review (in limited circumstances) under proposed new Rule 92bis.6 (see below).]

92bis.5 Objection to Change

Where the International Bureau has recorded a change under Rule 92bis.1 in the person of the applicant on the request of the new applicant but the person previously recorded as applicant, within two months from the date of the notification under Rule 92bis.4(c), submits a notice to the International Bureau objecting to the change, the change shall be considered as if it had not been recorded and the International Bureau shall further notify all of the addressees of that notification accordingly.

[COMMENT: See present Section 422bis of the Administrative Instructions. In the context of the proposed amendment of Rule 92bis, it is proposed to move the contents of present Section 422bis of the Administrative Instructions to the Regulations so as to deal with all issues relating to the recording of changes in just one place. It would appear that there is no need to extend the scope of proposed new Rule 92bis.5 beyond the case where an old applicant is, upon request of a new applicant, removed and replaced by the new applicant, noting that the present requirements as to representation and signatures would appear to ensure that that one (old) applicant cannot remove (all or any) other (old) applicants without their consent: where there is more than one applicant, any request for the recording of a change in the person of one of the applicants must be signed by, on behalf of, all applicants, including any applicant who is to be removed.]

92bis.6 Changes with Automatic Effect Under National Law

(a) A change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the applicant or the inventor, other than a change in person, that is notified to a designated Office under Rule 92bis.4(c) shall, subject to paragraph (d), have effect in the designated State or States concerned, unless that Office or a court or any other competent organ of or acting for that State finds that a requirement of Rule 92bis.2 or 92bis.3 was not complied with.

[COMMENT: See paragraphs 22 and 23 in the main body of this document.]

(b) A designated Office shall not review a decision of the International Bureau to record a change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the applicant or the inventor, other than a change in person, that is notified to that Office under Rule 92bis.4(c) unless it may reasonably doubt the veracity of an indication contained in the request for recording of the change or of a supporting document or a translation thereof, in which case it shall invite the applicant to furnish evidence to it within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

[COMMENT: See paragraph 23 in the main body of this document. Note that the requirement for reasonable doubt applies only to designated or elected Offices and not the courts or any other competent organs of or acting for the designated or elected States in order not to fetter the latter in the exercise of their discretion under national law.]

[Rule 92bis.6, continued]

(c) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) and (b) are not compatible with the national law applied by a designated Office, those paragraphs shall not apply to that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See paragraphs 24 in the main body of this document.]

(d) Where a change referred to in paragraph (a) is notified to a designated Office which has informed the International Bureau under Rule 92bis.2(e) of the need for a transliteration or translation but the request for the recording of a change did not comply with Rule 92bis.2(d), that change need not be taken into account by that Office.

[COMMENT: See paragraph 17 in the main body of this document.]

92bis.7 Changes with Effect only if Provided by National Law

A change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the person of the applicant or the inventor, or a change in an indication referred to in Rule 92bis.1(iii) or (iv) concerning the agent, the common representative or the address for correspondence, that is notified to a designated Office under Rule 92bis.4(b) shall have such effect, if any, as may be provided for under the applicable national law.

[Rule 92bis.7, continued]

[COMMENT: See paragraphs 25 and 26 in the main body of this document. It would not appear necessary to add a reservation provision with regard to the possible incompatibility of proposed new Rule 92bis.7 with the national law applicable by designated or elected Offices, since the effects of a change in an indication referred to in that Rule would only have such effect as may be provided for under the applicable national law.]

[End of Annex and of document]

THIS PAGE BLANK (USPTO)